

THIS DISPOSITION IS NOT CITABLE AS PRECEDENT
OF THE TTAB

JUNE 10, 1997

Hearing:
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Paper No. 20
EJS

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re La Creme, Inc.

Serial No. 74/412,080

John M. Cone of Strasburger & Price, L.L.P. for La Creme,
Inc.

Nora Buchanan Will, Trademark Examining Attorney, Law Office
101 (E. Ronald Williams, Managing Attorney)

Before Seeherman, Quinn and Walters, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

La Creme, Inc., doing business as La Creme Coffee and
Tea, has applied to register CAFFESORBETTO as a trademark
for "preparations for making mocha and coffee flavored soft
drinks."¹ A final refusal of registration has issued
pursuant to Section 2(e)(1) of the Trademark Act, 15 U.S.C.
1052(e)(1), on the ground that applicant's mark is merely

¹ Application Serial No. 74/412,080, filed July 13, 1993 and
asserting first use and first use in commerce on June 7, 1991.

descriptive of the identified goods. Applicant appealed, and an oral hearing was held before this Board.²

It is the Examining Attorney's position that, under the doctrine of foreign equivalents, the entire term CAFFESORBETTO is merely descriptive in that it immediately conveys the information that applicant's goods are used for making coffee-flavored iced drinks. The Examining Attorney bases this position on the Italian translations of the individual words, "caffe" and "sorbetto," which are translated, respectively, as "coffee, coffeehouse, or cafe" and "ice cream, iced drink, or sherbet." These translations were provided by applicant, and were confirmed by excerpts taken from Cassell's Italian Dictionary (1958), which were submitted with the Examining Attorney's appeal brief and which we judicially notice. The Examining Attorney has also made of record excerpts taken from the NEXIS data base which refer, in part, to "cafe sorbetto" or "caffesorbetto" as being "like a coffee milkshake,"³ "an espresso-flavored

² We note that there are certain references in applicant's papers which would be consistent with a claim of acquired distinctiveness. Specifically, with its request for reconsideration applicant submitted a declaration from a restaurant operator which states that he regards CAFFESORBETTO as a trademark of applicant's, and that to members of the trade and purchasing public it means the mix and drinks originating with applicant. And, in its reply brief, applicant refers to the NEXIS evidence as supporting the view that applicant's mark has acquired distinctive recognition. Reply brief, p. 5. However, applicant has never formally stated that it is seeking registration pursuant to Section 2(f), and aside from these two references there is no indication that such is applicant's intention. Accordingly, the sole issue before us is whether CAFFESORBETTO is inherently distinctive, or whether it is merely descriptive of applicant's goods.

³ "The Dallas Morning News," October 23, 1992.

granita,"⁴ "a lightly frozen blend of coffee and cocoa that has triple the caffeine content of regular coffee,"⁵ and an "iced cappucino dessert...made in a granita machine that whips and freezes the cappucino at the same time."⁶ Applicant has acknowledged that these references are to applicant's own product.

A term is merely descriptive, within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately conveys information concerning a quality, characteristic, function, ingredient, attribute or feature of a product or service. The question is not decided in a vacuum, but in relation to the goods on which, or the services in connection with which, the mark is used. **In re Venture**

Lending Associates, 226 TTAB 285, 286 (TTAB 1985).

Moreover, it is well established that the foreign equivalent of a merely descriptive English word is no more registrable than the English word itself, despite the fact that the foreign term may not be commonly known to members of the general public in the United States. **In re Atavio**, 25 USPQ2d 1361 (TTAB 1992); **In re Optica International**, 196 USPQ 775 (TTAB 1977).

We find that applicant's mark is merely descriptive, within the meaning of Section 2(e)(1) of the Act. The words CAFFE SORBETTO translate as "coffee iced drink," and applicant's product, as the record shows, is used to make a

⁴ "Supermarket News," May 10, 1993.

⁵ "Progressive Grocer," March 1995.

⁶ "The Houston Chronicle," September 23, 1992.

coffee-flavored iced soft drink. Although applicant's mark is depicted as one word, CAFFESORBETTO, rather than as the two words CAFFE SORBETTO, the running together of the words does not change the commercial impression of this term as being comprised of the words "caffe" and "sorbetto." This is evidenced by the fact that in many of the articles applicant's product is referred to as "caffe sorbetto" or "cafe sorbetto." Further, "caffe" and "sorbetto" are ordinary words which will be recognized by most people who are familiar with the Italian language, and they will immediately perceive that CAFFESORBETTO is a combination of these words, rather than some strange arbitrary term.

As a result, the present situation differs from that presented in **In re Ron Matusalem, Inc.**, 196 USPQ 458 (TTAB 1977), on which applicant relies. In that case, the Board found that, although RONCOCO was comprised of the individually descriptive words RON (rum) and COCO (coconut), the combination presented a unitary mark that the average purchaser would not attempt to translate.⁷

Applicant also argues that there are a multiplicity of meanings for the words involved, and that the Examining Attorney has made a contrived translation to reach the

⁷ Applicant also relies on **Jules Berman & Assoc. v. Consolidated Distilled Products**, 202 USPQ 67 (TTAB 1979). However, the facts presented in that case (it involved the issue of likelihood of confusion, and whether the fact that CHULA, which has a meaning in Spanish, would be known to consumers such that they would be able to distinguish this mark from KAHLUA, which has no meaning, based on the differences in connotation) are so different from those before us here that we do not find this case relevant to our decision herein.

conclusion that CAFFESORBETTO means coffee iced drinks. We are not persuaded by this argument. As noted above, the determination of whether a term is merely descriptive is not made in a vacuum, but is made in relation to the goods on which the mark is used. When viewed in connection with "preparations for making mocha and coffee flavored soft drinks," CAFFE will not be viewed as "coffeehouse" or "cafe," nor will SORBETTO be given the translation of "ice cream" or "sherbet." Rather, when the mark CAFFESORBETTO is considered in light of the identified goods, consumers will immediately translate the mark as "coffee iced drink," which translation is, in fact, merely descriptive of the goods.

Decision: The refusal of registration is affirmed.

E. J. Seeherman

T. J. Quinn

C. E. Walters
Administrative Trademark Judges
Trademark Trial and Appeal Board